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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,838	03/22/2001	Robert Icho	4168	6410
7590	08/26/2004		EXAMINER	
Harris Zimmerman Law Offices of Harris Zimmerman 1330 Broadway, Suite 710 Oakland, CA 94612-2506			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/815,838	ICHO, ROBERT	
	<b>Examiner</b> Jean D Janvier	<b>Art Unit</b> 3622	<i>UW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 March 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

#### **Status of the claims**

Claims 1-14 are now pending in the Instant Application.

### *Claim Objections*

The claimed invention is objected to because of the following informalities:

Throughout the claimed invention, “email” should be --e-mail--.

Concerning claim 9, line 2, in the limitations “...participating vendors include commission sponsors....”, the phrase “**commission sponsors**” does not play any significant role and thus, it will be broadly interpreted.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 (including dependent claims 2-14) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 20, recites "...and/or...", which renders the claim indefinite. It is unclear whether the Applicant wants to refer to **and** or **or**. For examination purpose, the Examiner assumes that the Applicant wants to refer to --or--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2-4, 9-11, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ikeda et al. (hereinafter Ikeda), US Patent 5,937,391A.

As per claims 1, 2-4, 9-11, 12 and 14, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores or shops within an online shopping mall (first reward program) comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of he customer or participant (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points (total points or base points) accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system shortens the time from issuing points to redeeming points. In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action) from a **home page or web site** of an online shopping mall and in response to this request, the service system causes the number of effective points (base points) accumulated by the customer and issued by a plurality of shops for each purchase made at each respective shop to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. **If the customer still decides to order a product (participant's action), he can click on a shopping button associated with one of the displayed shops to subsequently access an order button or a particular shop server or web site and hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order** (displaying a plurality of vendors on the program or shopping mall web site) (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a

customer can explicitly or implicitly make a request from the point-service system to buy a product from a participating shop, redeem points or simply query the point-service system database for the effective points (base points) accumulated to date. It is further to be recognized that a participating shop or vendor may or may not have its own server or web server or web site. Here, the steps of registering and storing the user's registration information including an e-mail address, reporting purchases made by the user at one or more shops or vendors for the purpose of providing points or credits to the user based on the purchases amounts and reiterating or repeating the process of reporting or tracking the user's purchases and crediting the user's account are implicitly or explicitly supported by Ikeda (col. 4: 41-60; col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3). **Additionally, the user or customer can access the online shopping mall or web site to check his or her number of accumulated and stored points and purchase history or information on the user's points stored under his account in a database can be periodically e-mailed to the user by a shopping mall or program web site administrator or manager, who also has an e-mail address** (or the process of e-mailing the customer may be carried out automatically using the manager's or program web site e-mail address) (col. 4: 34-38).

Moreover, the points issuing unit issues points based on the purchase amount of a customer or participant at an online shopping mall. The point issuing unit issues points based upon, for example, input information such as the name of the shop and the purchase amount and the points issue ratio set for each shop. For example, the points issue ratio is indicative of how many points are issued when a customer or participant spends 100 Yen at a shop (1 point for every 100 Yen spent). The points issue ratio can

also be set to a value larger than a normal value in a special campaign period such as an end-of-year sales period (col. 2: 28-37).

In addition, a points redeeming ratio performs a points redeeming process by reducing the purchase amount for a particular customer or participant during a transaction at a specific shop, based on the number of total points (base points or effective points) accumulated thus far throughout the system or at that shop, wherein the customer or participant chooses to redeem some of his points (base points) at the specific shop and wherein each participating shop has a different points redeeming ratio. For example, shop A of fig. 9 reduces during a certain period of time the customer's purchase by 1 Yen for every 1 point redeemed, hence a 1:1 ratio or redemption rate. Like the points issue ratio, the points redeeming ratio or redemption rate for a specific period, such as an end-of-year sales campaign, can be set to a value higher than a normal period (increasing or adjusting or providing a higher redemption points ratio or redemption rate to the customer if the customer performs an action such as purchasing products at a shop participating in the end-of-year sales campaign). (col. 2: 38-64; col. 3: 62-67; col. 8: 1-23; col. 9: 55 to col. 10: 2). In other words, each specific shop issues points to a customer or redeems the customer's effective points (base points) during a purchase transaction in accordance with the points issue ratio and points redemption ratio set for each specific shop during a specific period of time (**the shop or vendor issues or redeems points in accordance with its own prescribed points issuing and redeeming rates or ratios independent of the default ratios set by the program web site or shopping mall point service system**).

Finally, the steps of reporting a user's transaction data associated with a purchase or a redemption back to the shopping mall service system or program web site (especially if the shop or vendor uses its own server) for the purpose of providing points to the user for the purchase, for reconciling points after a redemption (especially when points issued from shop A are redeemed during a transaction at shop B and the redemption rate is unique) and for overall system management are implicitly supported by Ikeda. Further, it is silently disclosed that the points must be acquired from a points provider, as practiced in the art, such that, for example, a shop or vendor may have to acquire or purchase the points from the shopping mall service manager, especially if the shop distributes the points directly to the user (the shop may have to compensate the shopping mall manager for providing points to the registered users on behalf of the shop).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al. (hereinafter Ikeda), US Patent 5,937, 391.

As per claims 5-8, Ikeda teaches in general a points service system wherein a registered user conducts a purchase at a participating shop or vendor, which provides points or incentives to purchasers or registered users, and the transaction data related to the purchase are transmitted in real-time to the points issuing component of the system for rewarding or issuing points to the registered user based on the amount of the purchase.

Here, Ikeda does not explicitly disclose the steps of using by a registered user the e-mail address of the system manager or program web site during a transaction at a shop or vendor web site, reporting the user's purchase transaction via e-mail to the program

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web site or shopping mall system, confirming the user's purchase with the shop via e-mail and sending by the program web site an e-mail confirmation to the registered user.

However, using an e-mail as a communication means between two or more parties in a variety of ways is well established and well taught in the art. For example, a user who registers for a scheduled event via a web site associated with the scheduled event may receive an e-mail confirmation from the web site. Furthermore, a user or purchaser who purchases a product from a web site may receive an e-mail from the site to , for instance, confirm the purchase, to notify the user that the ordered item is out stock and will be delivered at a later date.

Moreover, transmitting the user's purchase transaction with a participating shop to the shopping mall system or program web site via e-mail, rather than a real-time transmission as taught by Ikeda, is a matter of desires, which does not directly impact how the points or credits are issued and redeemed.

(“Official Notice”)

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Ikeda's point service system so as to have a registered user provide an identifier such as an e-mail address related to the shopping mall system manager or program web site during a transaction at an associated shop or vendor web site in order to report in substantially real-time the user's purchase transaction via e-mail to the identified program web site or shopping mall system for confirming whether or not the current transaction is eligible to receive credits or points

and if the current transaction is eligible to receive points, then the user is notified via e-mail that the transaction has been completed and that a certain number of points has been added to his account as a result of the current transaction, thereby making it possible to identify which program web site or shopping mall system the user conducting the current transaction belongs to, especially when the shop or vendor web site where the user is shopping is associated with more than one shopping mall system or program web site (col. 4: 56-60).

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 5,806,045A to Biorgo et al. discloses a method and system for allocating and redeeming incentive credits between a portable device and a base device.

US Patent 6, 142, 371A to Omeda discloses a customer service system having a point value and discount rate.

US Patent 5, 537, 314 to Kanter discloses referral recognition system having a point and discount conversion tables.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM

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EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

08/19/04

A handwritten signature in black ink, appearing to read "Jennifer Komar".